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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/261,329	03/03/1999	KIM VILBOUR ANDERSEN	4887.204-US	7632

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NOVOZYMES NORTH AMERICA, INC.
500 FIFTH AVENUE
SUITE 1600
NEW YORK, NY 10110

EXAMINER

SLOBODYANSKY, ELIZABETH

ART UNIT PAPER NUMBER

1652

DATE MAILED: 09/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/261,329

Applicant(s)

ANDERSEN ET AL.

Examiner

Elizabeth Slobodyansky, PhD

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 207-249 is/are pending in the application.
- 4a) Of the above claim(s) 209-224 and 226-249 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 207 is/are allowed.
- 6) ☒ Claim(s) 208 and 225 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 207-249 are pending.

Election/Restrictions

Claims 209-224 and 226-249 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to the nonelected species, there being no allowable generic or linking claim.

Applicant's election of species of modified cellulases comprising a substitution at position 42 in addition to a substitution at position 119 with H in the reply filed on June 28, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 208 and 225 are rejected under 35 U.S.C. 102(b) as being anticipated by Convents et al.

Convents et al (US Patent 5,443,750) teach a cellulase having endoglucanase activity from *Humicola insolens* (SEQ ID NO:2, 305 amino acids). Said SEQ ID NO:2 is 78.8% identical to SEQ ID NO:5 of the instant invention and comprises substitution Q119H (numbering according to SEQ ID NO:1). It further comprises at least a substitution N42D and thus, anticipates claims 208 and 225.

Claims 208 and 225 are rejected under 35 U.S.C. 102(b) as being anticipated by Schulein et al.

Schulein et al (WO 94/07998, form PTO-1449 filed March 3, 1999) teach a cellulase having endoglucanase activity from *Humicola insolens* (SEQ ID NO:10, 284 amino acids). Said SEQ ID NO:10 is 78.8% identical to SEQ ID NO:5 of the instant invention and comprises substitution Q119H (numbering according to SEQ ID NO:1). It further comprises at least a substitution N42D and thus, anticipates claims 208 and 225.

The patentability of the product resides in the product and the claimed "modified cellulase" having a given amino acid sequence is indistinguishable from the cellulase from *Humicola* having the same amino acid sequence.

Allowable Subject Matter

Claim 207 is allowed.

Response to Arguments

Applicant's arguments filed April 13, 2006 have been fully considered but they are not persuasive.

With regard to the 102(b) rejection Applicants argue "The Humicola insolens endoglucanase disclosed in Convents et al. and Schulein et al. is a wild-type endoglucanase and not a modified cellulase, as claimed herein. Thus, this endoglucanase does not have the substitution Q119H or Q4R. As explained in the specification, e.g., at page 4, the modified cellulases of the present invention do not include wild-type cellulases" (Remarks of April 13, 2006).

This is not found persuasive because there is no way to distinguish between the man made variant and the wild type enzyme.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


Art Unit: 1652

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Slobodyansky, PhD whose telephone number is 571-272-0941. The examiner can normally be reached on M-F 10:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, PhD can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Elizabeth Slobodyansky, PhD
Primary Examiner
Art Unit 1652

September 12, 2006